

**REMARKS**

Claims 1-19 and 22 are pending in this application. Claims 1-7, 15-19 and 22 are withdrawn from consideration. By this Amendment, claims 20 and 21 are canceled. No new matter is added.

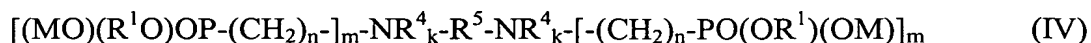
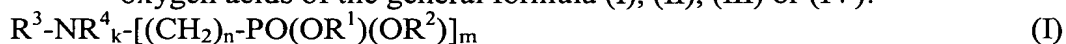
In view of the foregoing amendments and following remarks, reconsideration and allowance are respectfully requested.

**I. Rejection Under 35 U.S.C. §102/103**

The Office Action rejects claims 8-14 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 2,574,516 to Walter et al. ("Walter"); rejects claims 8-14 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over DE 1099257 or GB 895628 to Blum et al. ("Blum"); rejects claims 8-14 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over DE 3530358 to Von Bonin et al. ("Von Bonin"); and rejects claims 8-14 under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Study of mechanism of hydrogen sulfide corrosion..." to Rosenfeld ("Rosenfeld"). Applicants respectfully traverse the rejections.

Claim 8 recites (emphasis added):

A surface-modifying agent for structural steel, wherein it contains or consists of esters or ester salts, comprising alkoxy groups, of phosphorus-oxygen acids of the general formula (I), (II), (III) or (IV):



where

- n is an integer from 0 to 10,
- m+k is 2 and m is 1 or 2 and k is 0 or 1,

- at least one of the radicals  $R^1$ ,  $R^2$  and optionally  $R^3$  is an alkoxy group of the general formula  $-\text{[CH}_2\text{-CHR}^6\text{-O]}_l\text{R}^7$ , where  $l$  is from 2 to 30 and  $R^6$  and  $R^7$  are each H or  $\text{CH}_3$ ,  
     and the radicals  $R^1$  and  $R^2$ , where they are not alkoxy groups, are straight-chain or branched, optionally substituted  $\text{C}_1$ - to  $\text{C}_6$ -alkyl groups, and  $R^3$ , where it is not an alkoxy group, is a straight-chain or branched, optionally substituted,  $\text{C}_1$ - to  $\text{C}_{20}$ -alkyl group or aryl group,
- $R^4$  is H or a straight-chain or branched, optionally substituted  $\text{C}_1$ - to  $\text{C}_6$ -alkyl group,
- $R^5$  is a divalent, bridging group, and
- M is at least one cation selected from the group consisting of alkali metal, alkaline earth metal or ammonium ions.

The applied references fail to disclose, and likewise fail to teach, suggest, or establish any reason or rationale to provide the combination of features recited in claim 8.

In particular, the applied references fail to disclose, and likewise fail to teach, suggest, or establish any reason or rationale to provide the general formulas of claim 8 where at least one of the residues  $R^1$  and  $R^2$  (which are bound via an oxygen bond to the phosphorous atom) have an alkoxy group of the general formula  $-\text{[CH}_2\text{-CHR}^6\text{-O]}_l\text{R}^7$  (where " $l$ " is from 2 to 30 and  $R^6$  and  $R^7$  are each H or  $\text{CH}_3$ ). Walter merely discloses the presence of unsaturated aliphatic groups that are bound via an oxygen bond to the phosphorous atom, not alkoxy groups, much less alkoxy groups of the general formula  $-\text{[CH}_2\text{-CHR}^6\text{-O]}_l\text{R}^7$  (where " $l$ " is from 2 to 30 and  $R^6$  and  $R^7$  are each H or  $\text{CH}_3$ ) that are bound via an oxygen bond to the phosphorous atom, as required by claim 8.

Similarly, the residues  $R^1$  and  $R^2$  disclosed in each of the other the applied references that are bound via an oxygen bond to the phosphorous atom are not alkoxy groups of the general formula  $-\text{[CH}_2\text{-CHR}^6\text{-O]}_l\text{R}^7$  (where " $l$ " is from 2 to 30 and  $R^6$  and  $R^7$  are each H or  $\text{CH}_3$ ).

Thus, for at least the reasons discussed above, the general formulas recited in claim 8 are distinguishable from the structures disclosed in the applied references and thus the applied

references fail to disclose, and likewise fail to teach, suggest, or establish any reason or rationale to provide the combination of features recited in claim 8.

Accordingly, the applied references do not anticipate, and would not have rendered obvious claim 8. Claims 9-14 variously depend from claim 8 and, thus, also are not anticipated by and would not have been rendered obvious by the applied references. Reconsideration and withdrawal of the rejections are respectfully requested.

## **II. Rejoinder**

Applicants also respectfully request rejoinder of non-elected product claims 1-7 and method claims 15-19 and 22. Where restriction was required between independent or distinct products, and all claims directed to an elected invention are allowable, any restriction requirement between the elected invention and any non-elected invention that depends from or otherwise requires all the limitations of an allowable claim should be withdrawn. Claims that require all the limitations of an allowable claim should be rejoined and fully examined for patentability in accordance with 37 CFR 1.104. *See* MPEP §821.04(a). Because claims 1-7 include all the limitations of elected product claim 8, claims 1-7 must be rejoined with the product claims when the product claims are found allowable.

Furthermore, where product and process claims are presented in the same application, Applicants may be called upon under 35 U.S.C. §121 to elect claims to either the product or process. MPEP §821.04. However, in the case of an elected product claim, rejoinder will be permitted when a product claim is found allowable and the withdrawn process claim depends from or otherwise includes all the limitations of an allowed product claim. *Id.* Because process claims 16-18 include all the limitations of product claim 8, process claims 16-18 must be rejoined with the product claims when the product claims are found allowable.

Additionally, because process claims 15, 19, and 22 include all the limitations of product claim 1, process claims 15, 19, and 22 should be rejoined along with the non-elected product claims when the elected product claims are found allowable.

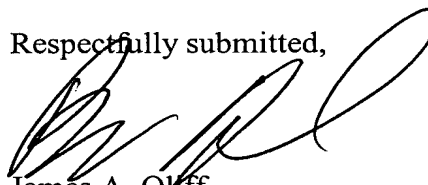
Because the elected product claims are believed to be allowable for at least the reasons presented above, Applicants respectfully request withdrawal of the Restriction Requirement and rejoinder of claims 1-7, 15-19 and 22

### **III. Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of the claims are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Benjamin S. Prebyl  
Registration No. 62,256

JAO:BSP

Date: September 11, 2009

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 320850**  
**Alexandria, Virginia 22320-4850**  
**Telephone: (703) 836-6400**

DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461
--